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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/870,342	05/29/2001	I-Wen Winnie Tsou	078525.0103	7717
5073 7590 01/08/2009 BAKER BOTTS L.L.P. 2001 ROSS AVENUE SUITE 600 DALLAS, TX 75201-2980				
EXAMINER BEKIRMAN, MICHAEL				
ART UNIT		PAPER NUMBER		
3622				
NOTIFICATION DATE		DELIVERY MODE		
01/08/2009		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ptomail1@bakerbotts.com  
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**Advisory Action  
Before the Filing of an Appeal Brief**

<b>Application No.</b> 09/870,342	<b>Applicant(s)</b> TSOU ET AL.
<b>Examiner</b> MICHAEL BEKERMAN	<b>Art Unit</b> 3622

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 03 December 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
 b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  
 Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
 (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
 (b) ☐ They raise the issue of new matter (see NOTE below);  
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
 5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
 6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
 7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
 The status of the claim(s) is (or will be) as follows:  
 Claim(s) allowed: \_\_\_\_\_.  
 Claim(s) objected to: \_\_\_\_\_.  
 Claim(s) rejected: \_\_\_\_\_.  
 Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
 12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_  
 13. ☐ Other: \_\_\_\_\_.

/Eric W. Stamber/  
 Supervisory Patent Examiner, Art Unit 3622

Continuation of 11. does NOT place the application in condition for allowance because:

Applicant argues "the Examiner is ignoring the words physical location as a modifier of the term information. The claims specifically require this type of information and, in fact, provide a Markush grouping reciting various examples of physical location information". Certain options under the Markush grouping in question include "phone number", email address information", and "one or more links to Internet websites". Examiner contends that there is no physical location inherent in any of these options. A cell phone number does not guarantee that a cell phone is located in any particular location. A website is not a physical location. An email address can be checked from any Internet-capable computer anywhere in the world. Further, regardless of the information that is received, the steps of the method are performed the same way. A device performing the method of Applicant's invention, except merely transmitting a different type of information instead of those listed in the Markush grouping would not be distinguishable as a different invention. A type of data is not a patentable distinction, and it would be obvious to send any type of data, as the type of data is not functionally relevant to the steps.

Applicant states that they have "chosen to be their own lexicographer" and argues "Paragraph 48 defines a click statistic as a statistic associated with the selection of presence information by instant messaging users". Examiner contends that the cited section of the specification is directed towards a "click statistics report", not a click statistic stored in a database. Further, the entire sentence from the specification states "A click statistics report may also be generated by IM server 302, which contains statistics associated with the selection of presence information by instant messaging users". First of all, this is not a definition, as Applicant has not stated that the term is not be defined as such. Second of all, it is unclear from this sentence if the click statistics report contains the particular statistics in question, or if the click statistics report may be generated by the IM server, and it is the IM server that contains the statistics in question.

Further, there is no "clicking" required by the claim language. There is no selection of data required by the claim. However, for the sake of argument, Examiner contends that the cited section of De Vries teaches the storing of selections, by buddies, of presence information requested to be viewed. While the language in paragraph 48 of the specification is not considered to be a definition of the term "click statistics", this interpretation meets the language in the specification.

Applicant argues "the Final Office Action first argues that this entry of user profile information is a disclosure of a statistic report sent by the user, but this is clearly not a statistic report given the broadest reasonable meaning of the term in light of the specification". Examiner contends that the data supplied is statistical data (coffee drinker, vegetarian, etc.) and therefore, according to a broadest reasonable interpretation this is in fact a statistics report. The claim does not limit the statistics report to exclude this type of information, and therefore this section of the prior art does indeed read over the broad claim language.

Applicant further argues "it is not a statistic report of the user's activity in selecting said business information of said business. A user providing profile information that the user is a coffee drinker or a vegetarian is clearly not related to a user's selection of the previously recited information of a business". Examiner would like to point out that this is not required by the claim language. The claim language recites "receive and store statistic reports on activity of said instant messaging user in selecting said business information of said business". Examiner reads this limitation as storing reports on the activity of a user, and those reports are used in selecting business information to provide to a user. Examiner reads the meaning of the word "in" as being similar to "in the interest of". While Applicant may have intended the claimed statistic report to include information relating to user-selected business information, this is not required by the claim as currently written.

Applicant argues "there is no disclosure that statistic reports are received from an instant messaging server or that they comprise information for business analysis and measurement of a marketing success of said transmitted business information". Changes to a profile would inherently occur through a server of the instant messaging network, and thus, the reports would be received from the server. The reports comprise information, but the analysis and measurement portions of the claim are intended use and do not actively limit the claim ("comprise information for business analysis and measurement of a marketing success"). Further, each of these recitations are recited in the claim language using wherein clauses, which also do not actively limit the claim.

MEPE 2114 states:

While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim.

MEPE 2106 (II) (C) states:

The subject matter of a properly construed claim is defined by the terms that limit its scope. It is this subject matter that must be examined. As a general matter, the grammar and intended meaning of terms used in a claim will dictate whether the language limits the claim scope. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. The following are examples of language that may raise a question as to the limiting effect of the language in a claim:

- (A) statements of intended use or field of use,
- (B) "adapted to" or "adapted for" clauses,
- (C) "wherein" clauses, or
- (D) "whereby" clauses.

USPTO personnel are to give claims their broadest reasonable interpretation in light of the supporting disclosure. Limitations appearing in the specification but not recited in the claim should not be read into the claim.

Applicant argues "De Vries does not disclose, teach or suggest presence information that includes a link to advertisements for a business". This is part of the physical presence information, and the same arguments used above are relevant here as well with regards to the non-functional descriptive material.